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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------|------------------|
| 10/748,624   | 12/30/2003  | Chen-Fa Huang        | PUSA031141 (15749/460) | 7506             |
| 23595  | 7590        | 07/23/2004           | EXAMINER               |                  |
| NIKOLAI & MERSEREAU, P.A.<br>900 SECOND AVENUE SOUTH<br>SUITE 820<br>MINNEAPOLIS, MN 55402 |             |                      | DURAND, PAUL R         |                  |
|  |             |                      | ART UNIT               | PAPER NUMBER     |
|  |             |                      | 3721                   |                  |

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/748,624 | <b>Applicant(s)</b><br>HUANG, CHEN-FA |  |
|                              | <b>Examiner</b><br>Paul Durand       | <b>Art Unit</b><br>3721               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Beals (US 3,820,705).

In regard to claim 1, Beals discloses the invention as claimed including a main body 12 and a magazine in the form of nail guide 34, mounted at the end of the main body (see Fig.1 and C2,L6-19).

In regard to claim 2, Beals discloses the invention as claimed including mounting seat in the form of retaining plate 24 and sleeve in the form of member 22, with a magazine mounted on the seat (see Figs. 1 and 2).

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Nield (GB 847,388).

In regard to claim 1, Nield discloses the invention as claimed including a main body in the form of cover tube 18 and a magazine 37, mounted at the end of the main body (see Fig.1, Pg.1,L62-71 and Pg.3,L29-36).

In regard to claim 2, Nield discloses the invention as claimed including a seat 23 and connecting tube in the form of front end cap 34 (see Figs.1 and 2).

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin (US 2004/0084501).

In regard to claim 1, Liu discloses the invention as claimed including a main body 2 and a magazine 70, mounted at the end of the main body (see Fig.2 and Paragraphs 0017 and 0018).

In regard to claim 2, Liu discloses the invention as claimed including a mounting seat in the form of groove 61 and connecting sleeve 67 (see Fig.9 and Paragraphs 0023 and 0024).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin or in the alternative Beals or in the alternative Nield in view of Chen (US 6,598,775).

Lin, Beals and Nield disclose the invention substantially as claimed as applied to claim 1 above including a main body, driving shaft, connecting sleeve and a guide tube that is integral with the connecting sleeve. What Lin, Beals or Nield do not disclose is a connecting sleeve and a guide tube that are separate parts. However, Chen teaches

that it is old and well known in the art of tool driving to provide a guide tube in the form of nail holder 13, which is movably attached to a connecting sleeve in the form of base 1, for the purpose of allowing the tool to be actuated by pressing the tool body in a downward motion (see Figs.1,2 and C2,L29-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Lin, Beals or Nield with the guide tube and sleeve arrangement as taught by Chen for the purpose of allowing the tool to be actuated by pressing the tool body in a downward motion.

In the alternative, Lin, Beals and Nield disclose the invention substantially as claimed as applied to claim 1 above including a main body, driving shaft, connecting sleeve and a guide tube that is integral with the connecting sleeve. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the invention of Lin, Beals or Nield with a separable guide tube and connecting sleeve, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

### ***Conclusion.***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Caringella, Wang-Kuan, Austin, Gassner and Smith have been cited to show devices having similar structure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
July 22, 2004



EUGENE KIM  
PRIMARY EXAMINER